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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,356	01/10/2002	Shih-An Cheng	INMEP0104US	2401

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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,356

Applicant(s)

CHENG ET AL.

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1> This action is in response to Applicant's request for continued examination. Claims 21 and 30 have been amended. Claims 21-34 are presented for further examination.

2> This is a non-final rejection.

Response to Arguments

3>

I. Applicant's amendment does not patentably distinguish over the prior art.

Applicant's amendment does not patentably distinguish over the prior art and Applicant's arguments are not persuasive for two reasons.

A. New limitation merely directed towards intended use and does not affect the physical structure of the invention.

It is noted that Applicant has amended the independent claims to recite that the VoIP is responsible to complete call establishment between the VoIP client and the selected termination PSTN gateway. In the remarks, Applicant further asserts that VoIP's client "is [not] tasked with call connection responsibilities". Applicant cites several sections in VoIP in an attempt to distinguish the claimed invention. In particular, Applicant asserts that VoIP teaches a control object, separate from the client, that is responsible for establishment of the PSTN circuit.

However, this cited functionality is not the same as the limitation claimed in Applicant's newly amended claim language. Completing call establishment (call connection

Art Unit: 2152

responsibility) is not the same as being responsible for establishing the end-to-end connections from the client to the destination (the functionality in Voit cited by Applicant). In fact, the portions cited in Voit are analogous the disclosure in Applicant's specification discussing that the PSTN gateway completely establishes end-to-end communications with the destination device [Applicant's specification, pg. 12 «lines 21-25»].

In response to applicant's argument that Voit does not disclose "complet[ing] call establishment between VoIP client and the selected termination PSTN gateway", this language merely is recitation of the intended use of the invention – that the VoIP client is intended to complete call establishment. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Here, the structural recitation in the claim is that the address of the PSTN gateway is provided to the VoIP client, the client utilizing the address to connect to the gateway. The new limitation does nothing to further limit the invention in any structural way; so as long as a prior art reference discloses the structure of the claim (providing an address and connecting to that address), then the prior art reference is necessarily capable of performing the intended use (completing call establishment).

Voit clearly discloses a VoIP client utilizing an IP address of the gateway (provided from a server) to initiate communications over the network [column 14 «lines 40-46»]. That is, the VoIP client is responsible for establishing a connection with the PSTN gateway (and the gateway is responsible for establishing the end-to-end connection with the destination)

Art Unit: 2152

[column 18 «line 60» to column 19 «line 24»]. Thus, Voit discloses providing a VoIP client with a network address of the selected termination PSTN gateway for the VoIP client to connect to the selected gateway to complete call establishment between the VoIP client and the selected gateway and to exchange voice data therewith [column 14 «lines 12-46» | column 18 «line 60» to column 19 «line 24» | column 23 «lines 19-34» | column 26 «lines 1-11»].

B. The new limitation is conventional and admitted prior art.

In regards to the newly amended limitation, as discussed throughout Applicant's specification, a conventional client may "complete" a call by merely connecting to the routing server or PSTN gateway [Applicant's specification, pg. 2 «lines 21-22» | pg. 3 «lines 18-19»]. In fact, Applicant further discloses that the call completion functionality utilized by his client (to connect to the PSTN gateway) is done "in an otherwise *conventional* manner" (italics provided) [pg. 7 «lines 16-17»]. The implication of Applicant's specification is that the newly amended limitation of complet[ing] call establishment" is a well known and conventional function in the art. Thus, the limitation is merely a user utilizing a received address for connecting to the PSTN gateway which, as discussed in section A, supra, is disclosed in Voit.

C. Conclusion

Thus, for the foregoing reasons, Applicant's amendment does not patentably distinguish over the prior art references and Applicant's arguments are not persuasive. The rejection set forth in the previous action, filed 10.25.2005, are maintained.

Art Unit: 2152

- 4> The rejections set forth in the previous office action, filed 10.25.2005:
- a. Claims 21, 27, 28 and 30 are rejected under 35 U.S.C § 103(a) as being unpatentable over Voit et al, U.S Patent No. 6.157.648 ["Voit"], in view of Scott et al, U.S Patent No. 6.760.324 ["Scott"].
 - b. Claim 22 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voit and Scott, in further in view of Scott et al. U.S Patent No. 6.480.898 ["Scott(2)"].
 - c. Claims 23-26 and 32-34 are rejected under 35 U.S.C § 103(a) as being unpatentable over Voit and Scott, in further in view of Pearce et al, U.S Patent No. 6.704.406 ["Pearce"].
- 5> The text of these sections of Title 35, U.S. Code not included in this action can be found in a prior Office action, filed 10.25.2005 and are not repeated in this action. The new limitation of the amendment is addressed in paragraph 3, section A of this action, supra.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Kelly, U.S Patent No. 6.347.085. In particular, Kelly discloses a VoIP client receiving an IP address of a gateway from a server, the client utilizing the received IP address to connect to the gateway [column 12 «line 12» to column 13 «line 67»].


Art Unit: 2152

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER